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10/685,750	10/15/2003	Mark Budzik	TRI4546P0170US	6164

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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EXAMINER

SPAHN, GAY

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/685,750
Filing Date: October 15, 2003
Appellant(s): BUDZIK, MARK

MAILED

MAR 15 2006

GROUP 3600

Allen J. Hoover
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03 January 2006 appealing from the Office action mailed 22 September 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct, except that Applicant has not listed the subject matter of independent claim 3. This was not seen as an error for which the examiner would need to send out a Notice of Defective

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Appeal Brief. However, if the Board of Appeals and Interferences deems this error to be one which requires correction, then they are invited to send out their own Notice of Defective Appeal Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct, except that they neglected to say that the ground of rejection covers all of claims 1-10 and their statement contains a typographical error in line 2, in that the word "are" should be --as--.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/013541 A1	KOENIG, JR.	9-2002
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6,684,586	HOFFMANN, SR.	2-2004
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HAWLEY'S Condensed Chemical Dictionary, Eleventh Edition, revised by N. Irving Sax and Richard J. Lewis, Sr., published by Van Nostrand Reinhold Company, Inc., New York, copyright 1987, definition of "foam, plastic" on page 534.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over KOENIG, JR. et al. (U.S. Patent Application Publication No. 2002/0134035 A1 published on September 26, 2002) in view of HAWLEY'S Condensed Chemical Dictionary and HOFFMANN, SR. (U.S. Patent No. 6,684,586).

As to independent claim 1, KOENIG, JR. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer (see lines 1-2 of Abstract, lines 2-3 of paragraph no. [0001] of Field of the Invention, lines 2-3 of paragraph no. [0005] of the Summary of the Invention, and lines 2-3 of paragraph no. [0011] of the Detailed Description of the Preferred Embodiment, all of which note that the drywall-trimming strip is "extruded from a polymeric material, such as polyvinyl chloride").

The examiner notes that HAWLEY'S Condensed Chemical Dictionary defines "foams, plastic" (see page 534) as follows:

A cellular plastic which may be either flexible or rigid. Flexible foams may be polyurethane, rubber latex, polyethylene or vinyl polymers, rigid foams are chiefly polystyrene, polyurethane, epoxy, and **polyvinyl chloride**. . . .
(Emphasis added).

Thus, KOENIG, JR. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride is considered to meet the claim recitation of a cellular polymer. However, it certainly would have been obvious to

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form the polyvinyl chloride (PVC) trimming strip (10) of KOENIG, JR. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by HAWLEY'S Condensed Chemical Dictionary.

KOENIG, JR. et al. fail to disclose claim 1's limitation that at least part of at least one of the expansive surfaces of the flange is characterized by open cells of the cellular polymer.

HOFFMANN, SR. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, HOFFMANN, SR. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of KOENIG, JR. et al. by milling, abrading or otherwise roughening at least a part of at least one of the expansive surfaces of the flanges thereof and contacting the same part of the same one of the expansive surfaces of the flange thereof to a drywall-finishing compound as taught by HOFFMANN, SR. in order to increase the surface area and thus expose the open cells of the cellular polymer to the drywall compound so that the drywall compound would better adhere to the drywall-trimming accessory.

As to independent claim 3, KOENIG, JR. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that KOENIG, JR. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from HAWLEY'S Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of KOENIG, JR. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by HAWLEY'S Condensed Chemical Dictionary.

KOENIG, JR. et al. fail to disclose claim 3's limitation that at least part of each expansive surface of the flange is characterized by open cells of the cellular polymer.

HOFFMANN, SR. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of each expansive surface

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of the flange thereof and contacting the same part of each expansive surface of the flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall compound would better adhere to the drywall-trimming accessory.

As to independent claim 5, KOENIG, JR. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that KOENIG, JR. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from HAWLEY'S Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of KOENIG, JR. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by HAWLEY'S Condensed Chemical Dictionary.

KOENIG, JR. et al. fail to disclose claim 5's limitation that at least part of at least one of the expansive surfaces of each flange is characterized by open cells of the cellular polymer.

HOFFMANN, SR. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, HOFFMANN,

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SR. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of KOENIG, JR. et al. by milling, abrading or otherwise roughening at least part of each expansive surface of the flange thereof and contacting the same part of each expansive surface of the flange thereof with drywall compound as taught by HOFFMANN, SR. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall compound would better adhere to the drywall-trimming accessory.

As to independent claim 7, KOENIG, JR. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that KOENIG, JR. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from HAWLEY'S Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of KOENIG, JR. et al. from a cellular, or

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open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by HAWLEY'S Condensed Chemical Dictionary.

KOENIG, JR. et al. fail to disclose claim 7's limitation that at least part of each expansive surface of each flange is characterized by open cells of the cellular polymer.

HOFFMANN, SR. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, HOFFMANN, SR. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of KOENIG, JR. et al. by milling, abrading or otherwise roughening at least part of each expansive surface of each flange thereof and contacting the same part of each expansive surface of each flange thereof with drywall compound as taught by HOFFMAN, SR. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall compound would better adhere to the drywall-trimming accessory.

(10) Response to Argument

Appellant's arguments filed 08 January 2006 have been fully considered but they are not persuasive.

Appellant first argues that "although polyvinyl chloride is capable of being foamed, polyvinyl chloride is not foamed ordinarily, that a disclosure of polyvinyl chloride

without any reference to its being foamed or its being cellular is not a disclosure of polyvinyl chloride being foamed or being cellular, and that is it improper hindsight to read into Koenig, Jr. *et al.* that its disclosure of polyvinyl chloride is a disclosure of a cellular polymer.” (Italics in original).

The examiner notes that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, reconstruction is proper. See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

The KOENIG, JR. et al. reference clearly states that the drywall-trimming accessory (i.e., strip 10) is extruded from polymeric material, such as polyvinyl chloride (see lines 1-2 of Abstract, lines 2-3 of paragraph no. [0001] of the Field of the Invention, lines 2-3 of paragraph no. [0005] of the Summary of the Invention, and lines 2-3 of paragraph no. [0011] of the Detailed Description of the Preferred Embodiment). Although the KOENIG, JR. et al. reference does not explicitly state that the polyvinyl chloride they are using to make their drywall-trimming strip is foamed or cellular, the examiner contends that it is well within the level of one of ordinary skill in art at the time the invention was made to know that polyvinyl chlorides exist in many forms, including foams and cellular polymers. Indeed, HAWLEY’S Condensed Chemical Dictionary defines “foam, plastic” as follows:

A cellular plastic which may be either flexible or rigid. Flexible foams may be polyurethane, rubber latex, polyethylene or vinyl polymers, rigid foams are chiefly polystyrene, polyurethane, epoxy, and polyvinyl chloride. . . . (Emphasis added).

Thus, KOENIG, JR. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride is considered to meet the claim recitation of a cellular polymer.

However, even if KOENIG, JR. et al.'s disclosure fails to meet the claim limitation of cellular polymer, it certainly would have been obvious to form the polyvinyl chloride drywall-trimming strip (10) of KOENIG, JR. et al. from a cellular, or open cell, polyvinyl chloride, since such is a well known and highly utilized polyvinyl chloride as expressed by HAWLEY'S Condensed Chemical Dictionary.

In response to Appellant's argument that there is no suggestion to form the KOENIG, JR. et al. corner strip of a cellular polyvinylchloride, the examiner notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present case, one having ordinary skill in the art at the time the invention was made would have found the suggestion to form a corner strip of KOENIG, JR. et al.

from a cellular polyvinyl chloride, (including closed as well as open cell), within the general knowledge of one of ordinary skill in the art as evidenced by HAWLEY'S Condensed Chemical Dictionary.

Next, Appellant argues that the examiner has drawn an improper conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory of KOENIG, JR. et al. by milling, abrading, knurling, or otherwise roughening at least a part of at least one of the expansive surfaces of the flanges thereof and contacting the same part of the same one of the expansive surfaces of the flange thereof with a drywall-finishing compound as taught by HOFFMANN, SR. in order to increase the surface area and thus expose the open cells of the cellular polymer to the drywall compound so that the drywall compound would better adhere to the drywall trimming accessory. In essence, Appellant appears to be arguing that there is no motivation to combine KOENIG, JR. et al. and HOFFMAN, SR.

In response to Appellant's argument that there is no motivation to combine the references, the examiner's motivation to combine KOENIG, JR. et al. with HOFFMAN, SR. is clearly set forth in HOFFMAN, SR. HOFFMAN, SR. recognizes that there are materials to which drywall compound does not adhere well (see col. 1, lines 52-54, wherein it states that "[p]olypropylene, however, is a material to which drywall compound and other construction adhesives do not adhere well"). Thus, HOFFMAN, SR. found a solution to this problem by milling or abrading or knurling or otherwise roughening the surface of the corner strip (col. 2, lines 19-22) in order to "increase the

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surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

Thus, the KOENIG, JR. et al. drywall-trimming accessory as modified by HOFFMAN, SR. would necessarily expose or open the cells of the polyvinylchloride as a result of the milling/abrading/knurling or otherwise roughening of the surface of the corner strip in order for the drywall compound to better adhere to the previously difficult-to-adhere material.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.



For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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PRIMARY EXAMINER
Art Unit 3673
March 9, 2006

Gay Ann Spahn, Patent Examiner
March 7, 2006

Conferees: Darnell M. Jayne, Appeal Conference Specialist 
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